

REMARKS

In the Final Office Action, the Examiner took the following actions:

rejected claims 1 and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Polizzi et al* (U.S. Patent Application Publication No. 2005/0086204) in view of *Botscheck et al* (U.S. Patent No. 7,340,679) and further in view of *Kukkal* (U.S. Patent No. 7,124,355);

rejected claims 2-7 under 35 U.S.C. § 103(a) as being unpatentable over *Polizzi* in view of *Botscheck* and further in view of *Kukkal*, and further in view of *Anuff et al* (U.S. Patent No. 6,327,628);

rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over *Polizzi* in view of *Botscheck*; and

rejected claims 10-15 under 35 U.S.C. § 103(a) as being unpatentable over *Polizzi* in view of *Botscheck* and further in view of *Anuff*.

Claims 1-7 and 9-16 remain pending in this application. it is requested that the rejections of the claims be withdrawn for at least the following reasons.

I. BOTSCHECK NOT AVAILABLE AS PRIOR ART UNDER §103(a)

A *prima facie* case of obviousness cannot be established for any of pending claims 1-7 and 9-16 for at least the reason that *Botscheck* is not available as prior art in a rejection under § 103(a) against the present application.

Pursuant to 35 U.S.C. § 103(c), subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), (g) of section 102 of this title, shall not preclude patentability where the subject matter and the claimed invention were, at the time of the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The published *Botscheck* patent application, U.S. Patent Application Publication No. 2003/0204429, which claims priority to U.S. Patent Application No. 10/137,212 filed on April 30, 2002, was filed on May 31, 2002 and has an earliest publication date on October 30, 2003. Applicants further note that the *Botscheck* patent application was issued as U.S. Patent No. 7,340,679 on March 4, 2008. Applicants, meanwhile, on September 15, 2003 filed the present application, which claims priority to a U.S. provisional application filed on April 24, 2002. Therefore, the published *Botscheck* patent application or the issued *Botscheck* patent can qualify as prior art, if at all, only under one or more of 35 U.S.C. § 102(e), (f), or (g). Moreover, *Botscheck's* U.S. application and the present application were, at the time of the present invention, owned by the same person or subject to an obligation of assignment to the same person, namely SAP AG, as set forth in 35 U.S.C. § 103(a). An assignment to SAP AG for both the present application and *Botscheck* is recorded in the assignment records at Reel/Frame 017347/0220.

As reflected in the American Inventors Protection Act of 1999, 35 U.S.C. § 103(c) states that prior art under 35 U.S.C. § 102(e) shall not preclude patentability of an invention if the invention was (1) developed by another person and (2) commonly owned or subject to an obligation of assignment to the same person. The published *Botscheck* patent application and the issued *Botscheck* patent meet both of these requirements because Joerg Beringer, an inventor of the present application, is not an inventor of *Botscheck* (i.e., Joerg Beringer is "another" person or inventive entity in the eyes of the law). Furthermore, as noted above, SAP AG is the assignee of both

Botscheck and the present application. Therefore, under 35 U.S.C. § 103(c) *Botscheck* is not available as prior art in the present application under 35 U.S.C. § 103(a).

As noted above, the Examiner rejected claims 1 and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Polizzi* in view of *Botscheck* and *Kukkal*; rejected claims 2-7 under 35 U.S.C. § 103(a) as being unpatentable over *Polizzi* in view of *Botscheck*, *Kukkal* and *Anuff*; rejected claims 9 under 35 U.S.C. § 103(a) as being unpatentable over *Polizzi* in view of *Botscheck*; and rejected claims 10-15 under 35 U.S.C. § 103(a) as being unpatentable over *Polizzi* in view of *Botscheck* and further in view of *Anuff*. However, since *Botscheck* is not available as prior art, the other applied references of *Polizzi* and *Kukkal* cannot stand alone, which the Examiner recognized in the Final Office Action. Without *Botscheck*, the 103(a) rejection of claims 1-7 and 9-16 cannot be maintained. Therefore, Applicants respectfully request the Examiner withdraw the rejection of claims 1-7 and 9-16 under 35 U.S.C. § 103(a).

CONCLUSION

Applicants respectfully request that the Examiner consider these remarks under 37 C.F.R. § 1.116, placing claims 1-7 and 9-16 in condition for allowance.


In view of the foregoing remarks, Applicants request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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